

### **REMARKS**

Claims 121-125 have been cancelled without prejudice or disclaimer. Applicants reserve the right to pursue these claims in one or more divisional applications.

Claims 25, 31, 50, 56, 73 79, 98 and 104 have been amended so as to recite individual highly antigenic regions of SEQ ID NO:2. Support for these amendments may be found in the specification as originally filed at, for example, page 8, lines 5-8. Each one of claims 32, 57, 80 and 105 has been amended so as to depend from an independent claim and to recite "at least seven contiguous amino acid residues." Support for these amendments may be found in the specification as originally filed at, for example, page 55, lines 28-34. Claims 39, 40, 42, 43, 63, 64, 66, 67, 87, 88, 90, 91, 111, 112, 114 and 115 have been amended so as to recite "the antibody or fragment thereof." Support for these amendments may be found throughout the specification and claims as originally filed. Accordingly, no new matter has been added.

Claims 25 to 120 are pending in this application upon entry of the present amendment. No new matter has been added.

#### **I Rejection Under 35 U.S.C. § 102**

The Examiner has maintained the rejection of claims 25-33, 35-37, 41, 44-58, 60, 61, 65, 68-81, 83-85, 89, 92-106, 108, 109, 113, 116-122 and 124-126 under 35 U.S.C. § 102(e) as allegedly being anticipated by Deen et al., U.S. Patent No. 6,013,476 (the '476 patent).

The Examiner agrees with Applicants that provisional application 60/041,796 (the '796 application) is the only Deen et al. disclosure which is relevant to the instant application for the purposes of analysis under 35 U.S.C. § 102(e). However, the Examiner alleges that:

[P]rovisional 60/041,796 disclosed a polypeptide sequence that is identical to amino acids -14 to 48 and 51-84 of SEQ ID NO:2 of the instant application. ... [F]or a disclosure to be anticipatory under 35 USC § 102 (e), the invention need only be described in a prior application; the disclosure need not demonstrate utility, or be enabled for using the protein. ... The instant claims are drawn to antibodies to portions of the polypeptide which were disclosed in the '796 application, the '796 application teaches antibodies to the polypeptide, and the '796 application therefore anticipates the claims.

See, Paper No. 12292003, at pages 4-5. Applicants respectfully disagree and traverse the rejection.

Preliminarily, Applicants point out that rejected claims 122 and 124-126 have been cancelled without prejudice or disclaimer, thereby obviating its rejection. Applicants reserve the right to pursue cancelled subject matter encompassed by the claims prior to the present amendment, in one or more continuing applications.

Applicants point out that presently rejected claims 25, 50, 73 and 98, and consequently all claims dependent therefrom, have been amended to recite individual highly antigenic regions of SEQ ID NO:2. Support for the recitation of individual highly antigenic regions of SEQ ID NO:2 is found in U.S. Provisional Application 60/052,991, filed June 11, 1997, to which the present application claims benefit under 35 U.S.C. § 119(e). See e.g., specification at page 7, lines 3-11, and page 13, line 27 through page 14, line 12. Applicants reserve the right to pursue subject matter encompassed by the claims prior to the present amendment, in one or more continuing applications.

Applicants respectfully point out that the present amendment of claim 25, 50, 73 and 98 has been made for the express purpose of excluding antibodies that bind polypeptides consisting of amino acid residues from about -14 to about 48 or from about 51 to about 84 of SEQ ID NO:2 of the present invention. Applicants do not surrender equivalents to the presently claimed subject matter consisting of antibodies that bind full-

length and mature TR9 polypeptides, as well as extracellular and cysteine rich domains of TR9 polypeptides of the instant invention, but not the 64 and 34 amino acid sequences disclosed in the '796 application of Deen et al.

In light of these amendments and remarks, Applicants respectfully request that the Examiner reconsider and withdraw the present rejection of claims 25-33, 35-37, 41, 44-58, 60, 61, 65, 68-81, 83-85, 89, 92-106, 108, 109, 113, 116-122 and 124-126 under 35 U.S.C. § 102(e).

## **II      Rejection Under 35 U.S.C. § 103**

**a**      The Examiner has maintained the rejection of claims 40, 64, 88 and 112 under 35 U.S.C. § 103(a) as allegedly “being unpatentable over Deen et al., U.S. Patent No. 6,013,476, and further in view of Abrams et al., U.S. Patent No. 5,112,954, May 12, 1992.” *See*, Paper No. 12292003, page 5. Applicants respectfully disagree and traverse the rejection.

Applicants respectfully point out that rejected claims 25, 50, 73 and 98, and consequently all claims dependent therefrom, have been amended to recite individual highly antigenic regions of SEQ ID NO:2. Therefore, Applicants submit that the '476 patent of Deen et al. is unavailable as art under 35 U.S.C. § 102 against the instant claims. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the present rejection of claims 40, 64, 88 and 112 under 35 U.S.C. § 103(a).

**b**      The Examiner has maintained the rejection of claims 42, 43, 66, 67, 90, 91, 114 and 115 under 35 U.S.C. § 103(a) as allegedly “being unpatentable over Deen et al., U.S. Patent No. 6,013,476, and further in view of Chester et al., U.S. Patent No. 5,876,691, March 2, 1999.” *See*, Paper No. 12292003, page 6. Applicants respectfully disagree and traverse the rejection.

Applicants respectfully point out that rejected claims 25, 50, 73 and 98, and consequently all claims dependent therefrom, have been amended to recite individual highly antigenic regions of SEQ ID NO:2. Therefore, Applicants submit that the '476 patent of Deen et al. is unavailable as art under 35 U.S.C. § 102 against the instant claims. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the present rejection of claims 42, 43, 66, 67, 90, 91, 114 and 115 under 35 U.S.C. § 103(a).

c The Examiner has maintained the rejection of claims 34, 38, 39, 59, 62, 63, 82, 86, 87, 107, 110, 111 and 123 under 35 U.S.C. § 103(a) as allegedly “being unpatentable over Deen et al., U.S. Patent No. 6,013,476, and further in view of Jakobovits et al., U.S. Patent No. 6,235,883, May 22, 2001.” *See*, Paper No. 12292003, page 6. Applicants respectfully disagree and traverse the rejection.

Preliminarily, Applicants point out that claim 123 has been cancelled without prejudice or disclaimer, thereby obviating its rejection. Applicants reserve the right to pursue cancelled subject matter encompassed by the claims prior to the present amendment, in one or more continuing applications.

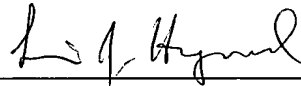
Applicants respectfully point out that rejected claims 25, 50, 73 and 98, and consequently all claims dependent therefrom, have been amended to recite individual highly antigenic regions of SEQ ID NO:2. Therefore, Applicants submit that the '476 patent of Deen et al. is unavailable as art under 35 U.S.C. § 102 against the instant claims. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the present rejection of claims 34, 38, 39, 59, 62, 63, 82, 86, 87, 107, 110 and 111 under 35 U.S.C. § 103(a).

**Conclusion**

In view of the foregoing remarks, applicants believe that this application is now in condition for allowance. The Examiner is invited to call the undersigned at the phone number provided below if any further action by applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,



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Enclosures  
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